



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/603,306	06/23/2000	Brian Wolfe	5053-36200	1775

7590 02/08/2005

Eric B Meyertons
Meyertons Hood Kivlin Kowert & Goetzel P C
PO Box 398
Austin, TX 78767-0398

EXAMINER

PASS, NATALIE

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/603,306

Applicant(s)

WOLFE, BRIAN

Examiner

Natalie A. Pass

Art Unit

3626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 11-25, 27-39, 41-51, 53-56 and 58-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-25, 27-39, 41-51, 53-56 and 58-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 22 December 2004.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the amendment filed 1 November 2004. Claims 1, 5, 21, 35 and 50 have been amended. Claims 10, 26, 40, 52 and 57 have been cancelled. Claims 60-63 have been newly added. The IDS statement filed 22 December 2004, which is stated by Applicant to be inclusive of a previously unconsidered IDS statement, has been entered and considered. Claims 1-9, 11-25, 27-39, 41-51, 53-56, 58-63 remain pending.

Specification

2. The objections to the specification under 35 U.S.C. 132 of the introduction of new matter into the disclosure is hereby withdrawn due to the amendment filed 1 November 2004.

Claim Rejections - 35 USC § 112

3. The rejection of claim 57 under the first paragraph of 35 U.S.C. 112 is hereby withdrawn due to the amendment filed 1 November 2004.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

Art Unit: 3626

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 9, 14, 16-20, 25, 30-34, 39, 44, 46-49, 56, 58, 60-61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711 in view of Kuwamoto et al, U.S. Patent Number 5, 483, 632 and further in view of Abbruzzese, U.S. Patent Number 5, 557, 515 for substantially the same reasons given in the previous Office Action (paper number 18). Further reasons appear hereinbelow.

(A) Claim 1 has been amended to recite the limitation "the insurance claims processing program" in line 14.

As per newly amended claim 1, Huffman, Kuwamoto and Abbruzzese teach a method comprising:

the insurance claim processing program estimating a bodily injury general damages value of the insurance claim by processing the insurance claim wherein the insurance claim comprises a bodily injury claim (Abbruzzese; column 24, line 52 to column 26, line 18, column 27, line 11 to column 28, line 58, column 29, line 58 to column 30, line 20, column 43, lines 45-49, column 47, lines 38-42, column 138, lines 55-58).

The remainder of claim 1 is rejected for the same reasons given in the prior Office Action (paper number 18, section 10, pages 5-8), and incorporated herein.

The motivations to combine Huffman, Kuwamoto and Abbruzzese are as discussed in the prior Office Action (paper number 18), and incorporated herein.

Art Unit: 3626

(B) As per newly added claims 60-61, Huffman, Kuwamoto and Abbruzzese teach a method as analyzed and discussed in claim 1 above further comprising

modifying at least one processing step of the insurance claim processing program in response to said displaying of the matching message text (Abbruzzese ; column 4, lines 27-44, column 5, lines 36-55, column 6, line 61 to column 7, lines 9, column 8, lines 36-49, column 15, line 61 to column 16, line 15), (Kuwamoto; Figure 2, column 2, line 60 to column 3, line 24, column 5, line 59 to column 6, line 4, column 6, line 56 to column 7, line 22, column 9, lines 7-24); and

wherein said specifying the message text of each entry in the database comprises modifying a help message (reads on modifying the message text) of at least one of the entries in the database during the installation of the insurance claims processing program on the computer system (Kuwamoto; Figure 4, Figure 10, Figure 14, see at least Item 1431, column 2, line 60 to column 3, line 64, column 5, lines 30-47, column 8, lines 28-42, 56-60, column 9, lines 45-67, column 10, lines 25-67).

The motivations to combine the respective teachings of Huffman, Kuwamoto and Abbruzzese are as discussed in claim 1 above and in the prior Office Action (paper number 18), and incorporated herein.

(C) Claims 2-4, 9, 14, 16-20, 25, 30-34, 39, 44, 46-49, 56, 58 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 18, section 10, pages 8-14), and incorporated herein.

6. Claims 5, 11-13, 15, 21, 27-29, 35, 41-43, 45, 50, 53-55, 62-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, as applied to claims 1, 17, 31 and 47 above, and further in view of Ertel, U.S. Patent Number 5, 307, 262 for substantially the same reasons given in the previous Office Action (paper number 18). Further reasons appear hereinbelow.

(A) Claims 5, 21, 35, 50, have been amended to substitute the words "at least one of the" for the words "one or more". While these changes render the language of the claims smoother and more consistent, they otherwise affect neither the scope and breadth of the claims as originally presented nor the manner in which the claims were interpreted by the Examiner when applying prior art within the previous Office Action.

As such, the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 18, section 11, pages 15-17), and incorporated herein.

The motivations to combine the respective teachings of Huffman, Kuwamoto, Abbruzzese and Ertel are as discussed in the prior Office Action (paper number 18), and incorporated herein.

(B) As per newly added claims 62-63, Huffman, Kuwamoto Abbruzzese and Ertel teach a method as analyzed and discussed in claim 5 above

wherein said customizing the message text of at least one of the entries in the database for a particular organization comprises modifying the message text of at least one of the entries in the database during an installation of the insurance claims processing program on a computer

Art Unit: 3626

system (Kuwamoto; Figure 4, Figure 10, Figure 14, see at least Item 1431, column 2, line 60 to column 3, line 64, column 5, lines 43-47, column 10, lines 25-67), (Ertel; column 11, lines 40-44, column 12, lines 31-37, 47-54, column 13, lines 37-45); and

wherein the particular insurance organization comprises a particular insurance company (Abbruzzese; column 67, lines 51-58).

The motivations to combine the respective teachings of Huffman, Kuwamoto, Abbruzzese and Ertel are as discussed in claim 5 above and in the prior Office Action (paper number 18), and incorporated herein.

(C) Claims 11-13, 15, 27-29, 41-43, 45, 53-55 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 18, section 11, pages 16-17), and incorporated herein.

7. Claims 6, 22, 36, 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, as applied to claims 1, 17, 31 and 47 above, and further in view of Winans, U.S. Patent Number 5, 307, 265 for substantially the same reasons given in the previous Office Action (paper number 18). Further reasons appear hereinbelow.

(A) Claims 6, 22, 36, 51 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 18, section 12, pages 17-18), and incorporated herein.

Art Unit: 3626

8. Claims 7-8, 23-24, 37-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, as applied to claims 1, 17, 31 and 47 above, and further in view of McGauley, U.S. Patent Number 5, 899, 998 for substantially the same reasons given in the previous Office Action (paper number 18). Further reasons appear hereinbelow.

(A) Claims 7-8, 23-24, 37-38 have not been amended and are rejected for the same reasons given in the previous Office Action (paper number 18, section 13, pages 18-19), and incorporated herein.

9. Claim 59 is rejected under 35 U.S.C. 103(a) as being unpatentable over Huffman, U.S. Patent Number 5, 870, 711, Kuwamoto et al, U.S. Patent Number 5, 483, 632 and Abbruzzese, U.S. Patent Number 5, 557, 515, and Ertel, U.S. Patent Number 5, 307, 262 as applied to claims 1 and 13 above, and further in view of Chen, et al, U.S. Patent Number 5, 504, 674 for substantially the same reasons given in the previous Office Action (paper number 18). Further reasons appear hereinbelow.

(A) Claim 59 has not been amended and is rejected for the same reasons given in the previous Office Action (paper number 18, section 14, pages 19-20), and incorporated herein.

Response to Arguments

10. Applicant's arguments filed 1 November 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the responses filed 1 November 2004.

(A) At page 14 of the 1 November 2004 response, Applicant apparently argues that a *prima facie* case of obviousness has not been established.

In response, the Examiner respectfully submits that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence of corresponding claim elements in the prior art has been presented and since Examiner has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention (see paper number 18). Note, for example, the motivations explicitly stated at lines 1-5 of page 7 of the previous Office Action (paper number 18) (i.e., "...with the motivation of providing a method and a system of help-information control whereby ..."); and at the paragraph bridging pages 7-8 of the previous Office Action (paper number 18) (i.e., "... with the motivation of minimizing the time to prepare and complete all insurance

Art Unit: 3626

forms, letters, reports and checks in processing insurance claims..."); and at the paragraph bridging pages 15-16 of the previous Office Action (paper number 18) (i.e., " ...with the motivation of managing the process of improving the quality and accuracy of reportable insurance claims data ... "); and at the paragraph bridging pages 17-18 of the previous Office Action (paper number 18) (i.e., " ... with the motivation of configuring each installation to be sensitive only to the language needs of users ... "); and at lines 1-8 of page 20 of the previous Office Action (paper number 18).(i.e., "... with the motivations of determining an appropriate cost for repairing or replacing damaged objects, including personal body injuries...".

(B) At page 14-21 of the 1 November 2004 response, Applicant argues that the features in the Application are not taught or suggested by the applied references. In response, all of the limitations which Applicant disputes as missing in the applied references, including the newly added features in the 1 November 2004 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Huffman, Kuwamoto, Abbruzzese, Ertel, Winans, McGauley, and Chen based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 18), and incorporated herein. In particular, Examiner notes that the recited features of "the insurance claim processing program estimating a bodily injury general damages value of the insurance claim by processing the insurance claim" are taught by the combination of applied references. Note, for example, that Abbruzzese teaches "[t]o illustrate the capabilities of this system and method, reference is made mainly to the

Art Unit: 3626

processing of insurance claims;" (emphasis added) and "[t]he claim number, policy number, insured and claimant name fields will pre-fill with the previously entered information. The Initial Reserve field will pre-fill with the original reserve which was entered in the LPTX [the "Loss Processing Transaction" - a series of input screens] and the Estimated Incurred and Paid fields will prefill with the most current totals;" (emphasis added) and "[a]n Injured Party screen is provided to enter information about any party injured in the accident (i.e., description of the injury, disability dates, claim descriptions, etc.);" and "[t]his facility automatically assigns a number... to each [insurance] claim ... [t]hese numbers are the primary method of accessing individual claims for processing and review" (emphasis added) (Abbruzzese; column 2, lines 62-64, column 24, line 52 to column 26, line 18, column 27, line 11 to column 28, line 58, column 29, line 58 to column 30, line 20, column 43, lines 45-49, column 47, lines 38-42, column 138, lines 55-58). Examiner interprets the estimated incurred fields "prefilling with the most current totals" as reading on "the insurance claim processing program estimating ...by processing the insurance claim" and Examiner respectfully submits that the teachings listed in this paragraph correspond to Applicant's argued claimed features.

With regard to Applicant's argument that the references do not suggest or imply the limitations of claims 17, 31 and 47, as argued on pages 16-18 of the 1 November 2004 response, Examiner notes that the combined references of Huffman, Kuwamoto, and Abbruzzese, and the knowledge generally available to one of ordinary skill in the art suggests or implies an insurance claims processing system comprising the recited claim. In particular, as noted in the preceding sections of the present Office Action and in the prior Office Action (paper number 18), and

incorporated herein, the applied prior art teaches program instructions which are executable by the CPU to perform the recited limitations of claim 17. Furthermore, Examiner notes that claims 17, 31 and 47 were rejected by the combined references of Huffman, Kuwamoto, and Abbruzzese, and that at pages 16-18 of the 1 November 2004 response, Applicant analyzes the applied references separately and argues each of the references individually. In response to Applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to Applicant's argument at pages 18-19 of the 1 November 2004 response that the applied references fail to disclose "specifying the message text of each entry in the database during an installation [or initialization] of the insurance claims processing program [or application] on a computer system," and "specifying the message text of each entry in the database during an installation [or initialization] of the database [or application] on a computer system" as recited in dependent claims 2 and 3, it is respectfully submitted that Applicant ignores the clear and unmistakable teachings of Kuwamoto with respect to recitations of "[w]hen application programs are incorporated into an information processing system [reads on "during an installation"], the storing position of the help data [reads on "the message text"] for each application program is stored in the help data management table ..." and "... a predetermined initial value is set to the help message identifier field of the block. The application program that opened the window may require modifying a help message [reads on specifying the message

text]...." Examiner interprets Kuwamoto's editing of help messages at installation or initialization of the program or application as reading on the argued limitations (Kuwamoto; Figure 4, Figure 5, Figure 10, Figure 14, see at least Item 1431, column 3, lines 29-54, column 5, lines 30-47, column 10, lines 25-67).

With respect to Applicant's argument at pages 18-19 of the 1 November 2004 response that the Ertel reference fails to teach the limitations of claims 2 and 3, Examiner respectfully notes that it was the Huffman, Kuwamoto, and Abbruzzese references, and not Ertel, that were applied to teach these limitations.

With respect to Applicant's argument at pages 19-20 of the 1 November 2004 response that the applied references fail to disclose the limitations of amended dependent claims 5, 21, 35, and 50, Examiner respectfully disagrees, noting that the combined applied art teaches these limitations. In particular, Ertel teaches "[s]hort, brief and full-text messages are available for each edit check. The content length of messages displayed or printed is dependent upon the appropriateness of detail to the recipient..." (Ertel; column 11, lines 40-44, column 12, lines 47-54); Abbruzzese teaches "[t]he Local Data function provides each office with the same number of generic numeric, date and alphanumeric fields (each of which is also of a predetermined length) to arrange into customized screens. Once these fields have been arranged into a particular display format for use in a local office, they can only be modified by an operator with the proper level of authority. Any number of these fields can be employed and there is no requirement that all/any of them be used. Since the fields are generic, they can be used in any

Art Unit: 3626

format to store any information desired by the local claims office," (Abbruzzese; column 9, lines 13-30). Examiner interprets these teachings as reading on "customizing the message text of one or more entries in the database for a particular insurance organization".

With respect to Applicant's argument at page 20 of the 1 November 2004 response that the applied references fail to disclose "wherein the requested message code comprises an injury code" and "wherein the requested message code comprises a treatment code" Ertel teaches "[o]ther adjunctive components include diagnosis and procedure code tables [databases], DRG assignment number tables, and other subsidiary files including one that contains special attributes associated with diagnosis and procedures...[t]hese consist of a collection of files containing error conditions and trigger elements that cause data quality messages to be generated for a given case...[s]pecific conditions or combinations of conditions such as the following are included in these tables: (49) certain individual diagnosis or procedure codes (50) code combinations (51) missing codes (given other conditions) (52) patient descriptor-code combinations (53) DRG assignments (54) DRG-code combinations" and "[s]hort, brief and full text messages are stored in these files and may be displayed on the computer screen and/or printed on worksheets 28 for each data quality edit that produces a message for a given case," (Ertel; column 11, lines 20-44). Examiner interprets these teachings as reading on the argued limitations. Therefore, Applicant's arguments are not persuasive.

As such, the Examiner respectfully submits that the burden of presenting a *prima facie* case of obviousness has at least been satisfied, since evidence has been presented of corresponding claim elements in the prior art as discussed above, and Examiner has expressly

articulated the combinations and the motivations for combinations as well as the scientific and logical reasoning of one skilled in the art at the time of the invention that fairly suggest Applicant's claimed invention as discussed in paper number 18 and above, incorporated herein.

Conclusion

11. **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

12. **Any response to this final action should be mailed to:**

Box AF

Commissioner of Patents and Trademarks
Washington D.C. 20231

or faxed to:

(703) 305-7687.

For formal communications, please mark
"EXPEDITED PROCEDURE".

For informal or draft communications, please label
"PROPOSED" or "DRAFT" on the front page of the
communication and do NOT sign the communication.


Hand-delivered responses should be brought to Crystal Park 5,
2451 Crystal Drive, Arlington, VA, Seventh Floor (Receptionist).

Art Unit: 3626

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Natalie A. Pass whose telephone number is (703) 305-3980. It should be noted that during the month of April 2005, the examiner's phone number will change to (571) 272-6774, however the current phone number will remain in service until the change takes place. The examiner can normally be reached on Monday through Thursday from 9:00 AM to 6:30 PM. The examiner can also be reached on alternate Fridays.

14. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas, can be reached at (703) 305-9588. It should be noted that during the month of April 2005, Joseph Thomas' phone number will change to (571) 272-6776, however the current phone number will remain in service until the change takes place. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 308-1113.

15. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Natalie A. Pass

February 2, 2005


ALEXANDER KALINOWSKI
PRIMARY EXAMINER